

REMARKS/ARGUMENTS

In the Restriction/Election of Species Requirement dated March 19, 2007, the Examiner delineated the following inventions as being patentably distinct:

- Group I: Claims 1-22, drawn to a process for obtaining a rubber mixture;
- Group II: Claim 23, drawn to a rubber mixture;
- Group III: Claim 24, drawn to a pigment, toner or ink; and
- Group IV: Claim 25, drawn to an adsorbent or absorbent.

The Examiner further required the election of a single species.

Accordingly, Applicants provisionally elect with traverse Group I, Claims 1-22, drawn to a process for obtaining a rubber mixture, and the species (ii) drying the solid.

The claims of Groups I-IV are integrally linked as compounds and method of making and the use thereof. The claims of Group I link together the claims of Groups II, III and IV as final product and method of making. The claims of Groups II, III and IV further define the invention of Group I and the refusal to examine the claims of Groups II-IV is a denial of substantive rights.

The Examiner has failed to show that the process claimed can be used to make another and materially different products or that the product can be made by another process. Batch verses continuous process is not considered to be an act of invention unless unexpected properties are produced, so that the Examiner's allegation that the products of the claimed invention can be made by another method such as a batch process is not persuasive.

There is a commonality that exists between the groups (I-IV). It is a technical relationship that involves the same feature, and it is this technical feature that defines the contributions which each of the groups taken as a whole make over the prior art.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if

restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims are patentably distinct. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim. It does not matter if a dependent claim itself contains a further invention.

Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement.

The Office has not shown that a burden exists in searching all of the claims.

Further, M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. The determination whether a group of inventions is so linked as to form a single general inventive concept should be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicants request that if the invention of Group I is found allowable, withdrawn Groups II-IV which include all the limitations of the allowable claims be rejoined.

Applicants also request that should the election of species be found allowable, the Examiner expand the search to include non-elected species.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double-patenting ground of rejection. 35 U.S.C. § 121, *In re Joyce* (Comr. Pats. 1957), 115 USPQ 412.

Application No. 10/722,414
Reply to Restriction/Election of Species Requirement of March 19, 2007

Applicants submit that the above identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Paul J. Killos
Registration No. 58,014